

AMENDMENTS TO THE DRAWINGS

Please replace the originally filed drawings with the attached replacement sheets of drawings (Sheets 1 through 10), which includes new Figures 2B, 3B, 7B and 8B. In Fig. 2B, a bag having a handle attached to the front of the bag is shown. In Fig. 3B, a bag having a handle attached to the back of the bag is shown. In Fig. 7B, a bag having a wheels rotably attached to the front of the bag is shown. In Fig. 8B, a bag having a wheels rotably attached to the rear of the bag is shown. No new matter has been added.

REMARKS

In the May 6, 2005, Office Action, the drawings were objected to by the Examiner under 37 CFR 1.83(a) because the feature disclosed in Claims 7 and 8 (wheels rotably secured to the back of the bag and a handle attached to the back and front of the enclosure) is not shown in the figures. Claims 7 and 8 were rejected under 35 U.S.C. § 112, second paragraph, with respect to the wheels/handle attachment to the enclosure – as related to the drawing objection.

In addition, Claims 1-5, 7-8, 10-15, 18-20 and 22-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lovett (US publication no. 200302001292). Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lovett '292 in view of Smith (US 6,447,114). In addition, Claims 6, 7, 16, 17 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovett '292 in view of Lovett (US publication no. 20040011840) or Smith '114.

Claims 1-3, 5-8 and 10-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lovett '840. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovett '840 in view of Lovett '292. Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovett '840 or Lovett '292 and Smith '114 in further view of O'Shea et al (US 5,782,325).

Claims 1, 2, 4-6, 10, 11, 14, 18, 19 and 22-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Smith '114. Finally, Claims 5 and 24 were rejected

under 35 U.S.C. § 103(a) as being unpatentable over Lovett '840 or Lovett '292 in view of Smith or Lovett (US 5,405,068).

Applicant regards his invention as a novel motorcycle bag and attachment system configured to permit the motorcycle bag to be securely mounted on to any make or model of motorcycle. In particular, Applicant's attachment system includes a closed ended pocket having a variable capacity or variable volume dimension so that the pocket may be adjusted to accommodate and securely fit over motorcycle sissy bars of a wide range of shapes and sizes – eliminating the need to manufacture and/or purchase a different motorcycle bag for each brand, make and/or model of motorcycle. Further, and contrary to the prior art, the pocket of the present invention is not removable or separable from the bag – indeed, one of the advantages of the present invention is the ability to attach the bag to any motorcycle, without the need to replace/substitute the pocket or any portion of the bag to accommodate different sissy bars.

Claims 1, 12, 18 and 23 have been amended to more clearly define the expandable pocket. In particular, Claims 1, 12, 18 and 23 have been amended to define the pocket as having a closed end – i.e. the pocket includes a close ended cavity or receptacle to securely enclose and retain a portion of the sissy bar. Further, Claims 1, 18 and 23 have been amended to include a pocket that is nonremovably and/or permanently affixed to the motorcycle bag – i.e., the pocket is not removable or separable from the bag.

**Objection to the Drawings**

Applicant has added Figures 2B, 3B, 7B and 8B to illustrate wheels rotably secured to the front (7B) and back of the bag (8B) and a handle attached to the back (3B) and front (2B) of the enclosure. No new matter has been included. In addition, the specification has been amended to include the addition of Figures 2B, 3B, 7B and 8B in the Description of the Drawings section of the specification. Replacement sheets including the proper renumbering of all the figures are attached hereto.

Accordingly, upon entry of Figures 2B, 3B, 7B and 8B Applicant believes the 35 U.S.C. § 112, second paragraph, rejection of Claims 7 and 8 should be withdrawn.

**Rejection of Claims 1-5, 7-8, 10-15, 18-20 and 22-24**

Claims 1-5, 7-8, 10-15, 18-20 and 22-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lovett (US publication no. 200302001292). However, Applicant respectfully submits that independent Claims 1, 12, 18 and 23, and all claims depending therefrom, are not anticipated by Lovett '292.

Lovett '292 discloses a motorcycle bag including an adjustable enclosure having first and second open ends, see paragraph [0015], lines 4-9. Importantly, the Lovett '292 attachment mechanism is not a pocket, but rather an open-ended sleeve or loop designed to permit the sissy bar to pass entirely through each of the first and second open ends, see also paragraph [0016], lines 3-6. Indeed, each and every embodiment described by Lovett '292 comprises a loop system having open top and bottom ends, see Figs. 1, 2, 4-6.

The open ended sleeve garners its adjustability from a series of layered panels. A panel 40a forms a first, open ended sleeve of fixed size for accommodating a small sissy bar, see Fig. 4 and paragraph [0017], lines 7-21. The area between panel 40a and 40b forms a second, open ended sleeve that is adjusted by completely undoing/unzipping one or both of zippers 46a and 46b.

Applicant notes that the Lovett '292 fastening mechanism requires the complete unfastening/undoing of the zippers to transition the sleeve from one size to the next, i.e. partial opening and closing of the zippers 46a and 46b is neither intended nor contemplated by Lovett '292, see also Lovett '840 paragraph [0023]. Indeed, such construction would not work in the Lovett '292 fastening mechanism design. In addition, regardless of the configured size, the Lovett '292 sleeve has the same size opening in its bottom portion as its top portion to permit the sissy bar to pass vertically therethrough.

Accordingly, the number of different sized sissy bars that can be accommodated by the Lovett '292 system is limited to the number of panels and zippers provided. For example, only four different sized motorcycle sissy bars can be accommodated with the adjustable sleeve described by Lovett '292. If additional sizes are required, additional panels and zippers are required, paragraph [0018], lines 13-16.

Claims 1, 12, 18 and 23 are distinguished from Lovett '292 by reciting a close ended, expandable pocket or receptacle. More specifically, the heart of the Lovett '292 invention is an open ended sleeve formed by a series of layered panels *through which* the top portion of the sissy bar *completely passes* – these panels are not intended nor capable

of configuration into a close ended pocket. In contrast, the motorcycle bag of the present invention includes an adjustable, close ended pocket that *retains the top portion of the sissy bar therein*, which is a wholly different design than the Lovett '292 adjustable enclosure. With respect to Claims 18 and 23, Lovett '292 clearly does not disclose or claim an expandable pocket having a closed top portion.

In addition, there is no teaching, suggestion or motivation in Lovett '292 to provide a close ended pocket. In particular, if the top portion of either layer 40a or 40b were secured to the rear surface 44 of the bag 10, the zippers 46a and 46b could not fully unzip preventing the layered panels from properly or fully expanding to the next size sleeve. Clearly, a closed ended sleeve prohibits a sissy bar from passing through both of the first and second open ends, as required by Lovett '292

In light of the foregoing, it is respectfully submitted that Claims 1, 12, 18 and 23 clearly distinguish over and are nonobvious in light of Lovett '292. Accordingly, Claims 1, 12, 18 and 23, and all claims depending therefrom, are patentable over Lovett '292.

#### **Rejection of Claim 6**

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lovett '292 in view of Smith (US 6,447,114). Claim 6 depends from Claim 1 which is believed to be patentable over Lovett '292 for the reasons given above.

Smith, cited for disclosing quick release straps, neither discloses nor suggests modification of what is disclosed by Lovett '292 that would anticipate or render obvious Claim 1. Therefore, Claim 6 is believed to be patentable along with parent Claim 1.

**Rejection of Claims 6, 7, 16, 17 and 21**

Claims 6, 7, 16, 17 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovett '292 in view of Lovett (US publication no. 20040011840) or Smith '114. Claims 6 and 7 depend from Claim 1, Claims 16 and 17 depend from Claim 12 and Claim 21 depends from Claim 18.

However, with regard to dependent Claims 6, 7, 16, 17 and 21 neither Smith nor Lovett '840 discloses or suggests modification of Lovett '292 that would anticipate or make obvious Claims 1, 12 or 18, see also the detailed discussion below of both the Lovett '840 and the Smith references. Accordingly, Claims 6, 7, 16, 17 and 21 are believed patentable over Lovett '292, Lovett '840 and Smith '114, along with parent Claims 1, 12 and 18.

**Rejection of Claims 1-3, 5-8 and 10-24**

Claims 1-5, 7-8, 10-15, 18-20 and 22-24 were rejected under 35 U.S.C. § 102(e) as being anticipated by Lovett (US publication no. 2004001840). However, Applicant respectfully submits that independent Claims 1, 12, 18 and 23, and all claims depending therefrom, are not anticipated by Lovett '840.

Lovett '840 discloses a motorcycle bag having a retractable handle and wheels for rolling the bag. Applicant notes that the fastening mechanism 19 illustrated in Figs. 6a, 6b and 6c of Lovett '840 is the same fastening mechanism disclosed in Lovett '292, as described in paragraph [0024] of Lovett '840. An alternate fastening mechanism 63 disclosed for use with the Lovett '840 rolling bag is the same fastening mechanism 63 disclosed in U.S. Patent 5,404,068 – a *one-size-fits-one sissy bar* pocket that is neither adjustable nor expandable to fit a variety of different sized sissy bars, see paragraph [0025] of Lovett '840. Another fastening mechanism described by Lovett '840 is a series of straps 65, 69 – the same fastening mechanism disclosed in U.S. Patent 6,123,239, as described in paragraph [0026] of Lovett '840.

With regard to fastening mechanism illustrated in Figs. 6a-6c of Lovett '840, Claims 1, 12, 18 and 23 are distinguished from Lovett '840 by reciting a close ended, expandable pocket or receptacle – for the same reasons discussed above with reference to Lovett '292.

Further, Claims 1, 12, 18 and 23 are distinguished from Lovett '840, and Lovett 5,404,068 for that matter, by reciting a expandable pocket or receptacle that is of variable volume such that a plurality of different sized-sissy bars can be accommodated therein. In direct contrast, and as discussed in more detail in the '068 reference, the sung fitting one-size-fits-one pocket is central to the successful operation of the Lovett motorcycle bag, *see* Lovett '068 reference, Col. 3, lines 47-52. Indeed, the pocket of Lovett '068 must be sized such that its internal volume is less than the volume of the padded seat



back, *see id.* Lovett '068 unequivocally states that the pocket 2 is specifically designed to fit only one make or model of motorcycle seat back and thus clearly teaches away from a variable volume pocket, see Col. 3, lines 65-68

Finally, Claims 1, 12, 18 and 23 are distinguished from the strap embodiment described in Lovett '840 (and also in Lovett 6,123,239) because such embodiment clearly does not include a close ended pocket.

In light of the foregoing, it is respectfully submitted that Claims 1, 12, 18 and 23, and all claims depending therefrom, clearly distinguish over Lovett '840 and are therefore patentable over Lovett '840.

#### **Rejection of Claim 4**

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovett '840 in view of Lovett '292. Claim 4 depends from Claim 1.

However, as described in more detail above, Lovett '840 does not disclose, teach or suggest modification of Lovett '292 that would anticipate or render obvious Claim 1. Indeed, Lovett '840 incorporates by reference the teachings of Lovett '292 without suggesting modification thereof. Therefore, it is asserted that the present claims, including Claims 1 and 4, are patentable over Lovett '840 in view of Lovett '292.

#### **Rejection of Claim 9**

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovett '840 or Lovett '292 and Smith '114 in further view of O'Shea et al (US 5,782,325). Claim

9 depends from Claim 1 which is believed to be patentable over Lovett '840 and Lovett '292 for the reasons given above.

Smith, cited for disclosing quick release straps, neither discloses nor suggests modification of Lovett '840 and/or Lovett '292 that would anticipate or make obvious Claim , see also the detailed discussion below of the Smith reference. O'Shea, cited for providing a retractable handle with a handle seat on the top of the enclosure, neither discloses nor suggests modification of what is disclosed by Lovett '292, Lovett '840 or Smith that would anticipate or render obvious Claim 1. Therefore, Claim 9 is believed to be patentable along with parent Claim 1.

**Rejection of Claims 1, 2, 4-6, 10, 11, 14, 18, 19 and 22-24**

Claims 1, 2, 4-6, 10, 11, 14, 18, 19 and 22-24 were rejected under 35 U.S.C. § 102(b) as being anticipated by Smith '114. Applicant respectfully asserts that independent Claims 1, 18 and 23, and all claims depending therefrom, are not anticipated by Smith.

Smith discloses a motorcycle bag having a *one-size-fits-one sissy bar pocket* that is *removably attached* to the bag, see Co. 2, lines 58-60 and claims. Smith teaches a removable pocket of a fixed size/volume, particularly designed to fit a specific make or model of motorcycle seat back. The Smith pocket must be removable so that a pocket of a first size can be removed and replaced with a pocket of a second size in order to permit the motorcycle luggage to fit on motorcycles of different manufacturers or models.

Indeed, Smith teaches that the removable pocket system is advantageous over adjustable attachment systems which are time consuming process of having to properly install, size and remove an adjustable attachment system (such as Lovett U.S. 6,123,239), see Col. 1, lines 34-39. Smith solves this problem of the prior art by designing a fixed volume, removable pocket system.

Claims 1, 18 and 23 are clearly distinguished from Smith by reciting a *nonremovable* and/or *permanently* affixed or secured, close ended pocket for accommodating a plurality of different sized-sissy bars. The present invention comprises a bag having a nonremovable pocket designed to accommodate a wide range of different sissy bar sizes without the need to replace or exchange the pocket with another pocket when the bag is mounted to a different motorcycle – an advantage of the Applicant's configuration. In direct contrast, the pocket on the Smith bag is removable, and the Smith pockets must come in a variety of sizes so that a pocket of appropriate size can be removably secured to the bag to accommodate a specific brand or model of motorcycle.

In light of the foregoing, it is respectfully submitted that Claims 1, 18 and 23, and all claims depending therefrom, clearly distinguish over Smith '114 and are therefore patentable over Smith '114.

#### **Rejection of Claims 5 and 24**

Claims 5 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovett '840 or Lovett '292 in view of Smith or Lovett (US 5,405,068). Claim 5

depends from Claim 1 and Claim 24 depends from Claim 23, which are believed to be patentable over both Lovett '840 and Lovett '292 for the reasons given above.

In response to the Examiner's that Lovett '840 and Lovett '292 do not teach a top edge secured to the enclosure – it is submitted that the open ended sleeve of Lovett '292 (and the identical sleeve incorporated by reference into Lovett '840) would not work for its intended purpose if the top edge were secured to the enclosure. As discussed herein, if the top edge of either panel 40a or 40b (of Lovett '292) were securely attached at a top edge to the enclosure, the sleeve would (1) no longer be open ended as required by Lovett '292, and therefore, (2) the sissy bar would be prohibited from being inserted through the sleeve.

Nonetheless, because Lovett '292 discloses an adjustable sleeve to fit more than one sissy bar, it can not be properly combined with Lovett '068 – as Lovett '068 teaches a divergent, totally different fastening mechanism that is specifically designed to fit *only one motorcycle seat back* and it is not adjustable or configurable in any manner. Clearly, these two references teach away from each other

Moreover, Lovett '840 in combination with Lovett '068 does not teach or suggest the limitations of Claims 5 or 24. In fact, Lovett '840 does not disclose, teach or suggest modification of Lovett '068 that would anticipate or render obvious Claims 1 or 23. Indeed, Lovett '840 incorporates by reference the teachings of Lovett '068 without suggesting modification thereof. Therefore, it is asserted that the present claims, including Claims 5 and 24, are patentable over Lovett '840 in view of Lovett '292.

Finally, because Claims 1 and Claim 23 are believed to be patentable over both Lovett '840 and Lovett '292, the teaching of Smith '114 does not disclose or suggest modification of Lovett '292 or Lovett '840 that would anticipate or render obvious Claims 1 or 23. Therefore, Claims 5 and 24 are believed to be patentable along with parent Claims 1 and 23.

In summary, Claims 1 through 24 are believed to be allowable for the reasons given herein. Accordingly, these claims remain pending following entry of this Amendment, and are believed to be in condition for allowance at this time. As such, Applicant respectfully requests entry of the present Amendment and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicant's undersigned representative at the number listed below.

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